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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TADAMASA KITSUKAWA

Appeal 2009-010974
Application 09/802,635
Technology Center 2400

Before, JOSEPH F. RUGGIERO, ROBERT E. NAPPI, and
DAVID M. KOHUT, *Administrative Patent Judges*.

KOHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the final rejection of claims 1-5 and 7-9.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part the Examiner's rejection of these claims.

¹ Claims 6 and 10-26 were previously cancelled.

INVENTION

The invention is directed to a method for billing for interactive television that includes virtual channels that represent Web sites. *See Spec:*

3-4. Claim 1 is representative of the invention and is reproduced below:

1. A method for billing for interactive television, comprising the acts of:

establishing an access restriction table for at least one consumer, the access restriction table listing plural virtual channels and an access flag for each channel, each access flag indicating whether the channel can be accessed based on user ID;

enabling the consumer to use a television to access content associated with a virtual channel;

selectively restricting access to content using the access flags;

recording at least one access record based on consumer access activity related to the content; and

billing an entity at least partially based on the access record.

REFERENCE

Watson	US 5,289,271	Feb. 22, 1994
Urakoshi	US 6,067,564	May 23, 2000
Connelly	US 6,144,376	Nov. 7, 2000
Linehan	US 2004/0249726 A1	Dec. 9, 2004 (filed Jul. 14, 2004)

REJECTIONS AT ISSUE

Claims 1-3, 5, and 7-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Connelly in view of Urakoshi and Watson. Ans. 3-7.

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Connelly in view of Urakoshi, Watson, and Linehan. Ans. 7-8.

ISSUES

Claims 1-3, 5, and 7-9

Appellant argues on pages 3-5 of the Appeal Brief and pages 1-3 of the Reply Brief that the Examiner's rejection of claims 1-3, 5, and 7-9 is in error. These arguments present the following issues:

- a) Did the Examiner use impermissible hindsight to combine Urakoshi and Watson with Connelly?
- b) Did the Examiner err in finding that Connelly in view of Urakoshi and Watson discloses an access flag for each channel, each access flag indicating whether the channel can be accessed based on user ID?

Claim 4

Appellant argues on pages 5-6 of the Appeal Brief and page 3 of the Reply Brief that the Examiner's rejection of claim 4 is in error. These arguments provide the following issue: did the Examiner err in finding that Connelly in view of Urakoshi, Watson, and Linehan discloses billing an entity wherein the entity is an owner or publisher of accessed content?

ANALYSIS

Claim 1

Appellant's arguments have persuaded us of error in the Examiner's rejection of claim 1. Claim 1 recites "establishing an access restriction table for at least one consumer, the access restriction table listing plural virtual

channels and an access flag for each channel, each access flag indicating whether the channel can be access based on user ID.” The Examiner finds that Urakoshi discloses a system that has an access restriction table in the form of a channel guide that indicates what channels may be viewed based upon the channel’s color, which is the same as an access flag. Ans. 12. The Examiner also finds that each channel’s data set, along with a user ID and password, determine the color, i.e., flag, to be displayed that indicates whether a channel can be accessed. Ans. 12. Appellant argues that Urakoshi’s program purchase menu 60, containing a user ID and password, is only used to purchase PPV programming. App. Br. 4. Additionally, Appellant contends that the program display mode is not associated with a user. App. Br. 4. We agree with Appellant.

Urakoshi discloses a system where a charge amount and/or rating for television programming can be set prior to viewing programming. Col. 6, ll. 1-16. These settings are compared to program data and channels are displayed in a program guide in a particular color to indicate which programs either contain or do not contain the specified criteria. Col. 7, l. 44-col. 8, l. 6. However, Urakoshi’s system does not base which channels are to be displayed in a program guide based upon a user ID, as claimed. The only mention in Urakoshi of a user ID is for purchasing pay-per-view programming. Col. 5, ll. 9-14. Thus, the Examiner has not shown an access restriction table that lists an access flag for each channel indicating whether the channel can be accessed based on a user ID. The additional teachings of Connelly and Watson do not make up for the deficiencies noted above. Therefore, we will not sustain the Examiner’s rejection of claim 1.

Claims 2-3, 5, and 7-9

While Appellant's arguments have persuaded us of error in the Examiner's rejection of independent claim 1, we are not persuaded of error in the Examiner's rejection of independent claim 2 and dependent claims 3, 5, and 7-9, as these claims contain different limitations than claim 1.

Appellant's arguments that are generally directed toward these claims include the argument that the combination of the references is based upon hindsight reasoning since neither Urakoshi nor Watson mentions a virtual channel and Connelly does not mention an access restriction table or billing. App. Br. 4-5. Appellant's arguments are not persuasive of reversible error for the reasons stated in the Examiner's Answer. We add the following for emphasis.

First, as explained in *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971):

Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.

Our review of the record establishes that the Examiner's case for obviousness is only based on knowledge which was within the level of ordinary skill at the time of the Appellants' invention and does not include knowledge gleaned only from the Appellant's disclosure.

Second, the Examiner identifies the relevant portions of each of the references relied on throughout the Examiner's Answer. *See* Ans. 3-5 and 11-14. To the extent that the Examiner relies on the knowledge of one of

ordinary skill in the art to combine the teachings of the references, this practice is consistent with current case law. For example, in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), the Supreme Court explains:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed.2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

In this case, the Examiner’s conclusions of obviousness are clearly articulated and are based on detailed factual findings that are supported by the references of record. *See* Ans. 3-5 and 11-14.

Appellant additionally argues on pages 1-3 of the Reply Brief that “the Answer . . . should be reviewed for error under the TSM test without regard to non-TSM KSR rationales” since the Examiner “ignore[s] the new KSR rationales by repeating the grounds for rejection that were rendered under the pre-KSR teaching-suggestion-motivation (TSM)-only test.” Reply Br. 1-2. We disagree with Appellant’s argument. The Examiner has not ignored the “new” *KSR* rationales. The Examiner simply chose to use the TSM test to prove that the combination was obvious by providing a

motivation to combine the references. Ans. 13-14. The Examiner stated that the combination would “allow parents to control the content that their child accesses.” Ans. 14. In response, Appellant does not argue the sufficiency of the motivation, but rather argues that the references do not disclose a “flag for each channel.” Reply Br. 2. These arguments are directed toward the rejection of claim 1 not claim 2 since claim 2 does not recite a “flag for each channel.” Since there are no other arguments directed to the rejection of claims 2-3, 5, or 7-9, we find the Examiner’s motivation to be sufficient.

For the reasons stated *supra*, we sustain the Examiner’s rejection of claims 2-3, 5, and 7-9.

Claim 4

Appellant’s arguments have persuaded us of error in the Examiner’s rejection of claim 4. Claim 4 requires billing an entity wherein the entity is the owner or publisher of the content accessed. Appellant argues that Linehan does not disclose billing an owner or publisher. App. Br. 6. We agree.

Linehan discloses a system wherein a merchant is hosted by a satellite TV system operator and a purchase is made by a consumer using the television. ¶ [0037]. However, the satellite TV system operator does not bill the merchant. Instead, the purchase captures TV context information and when the charge is posted to a consumer’s credit card by the acquiring bank, the bank allocates revenue to the TV originator. ¶ [0063]. Thus, the owner or publisher is never billed. The additional teachings of Connelly, Urakoshi, and Watson do not make up for the deficiencies noted above. Therefore, we will not sustain the Examiner’s rejection of claim 4.

CONCLUSION

In regards to claims 2-3, 5, and 7-9, the Examiner did not use impermissible hindsight to combine Urakoshi and Watson with Connelly.

In regards to claim 1, the Examiner erred in finding that Connelly in view of Urakoshi and Watson discloses an access flag for each channel, each access flag indicating whether the channel can be accessed based on user ID.

In regards to claim 4, the Examiner erred in finding that Connelly in view of Urakoshi, Watson, and Linehan discloses billing an entity wherein the entity is an owner or publisher of accessed content.

SUMMARY

The Examiner's decision to reject claims 1 and 4 is reversed and claims 2-3, 5, and 7-9 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136 (a)(1)(iv).

AFFIRMED-IN-PART

msc